

REMARKS

At the time of the Third Office Action dated April 4, 2008, claims 1-18 were pending and rejected in this application.

CLAIMS 1-2, 4, 8-9, 11-13, AND 15-17 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 2 of the Third Office Action, the Examiner asserted that the terms "observing" and "subsequently" are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

At the outset, Applicants are unclear as to why the Examiner did not raise this alleged issue in the First or Second Office Actions. Also, Applicants are unclear as to why the Examiner believed these claim terms were previously definite but now are ambiguous.

With regarding to the term "observing," the Examiner asserted the following on page 2 of the Third Office Action:

The term "observing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. State changes and action invocations are rendered indefinite by the use of the term "observing".

For purposes of examination observing state changes and action invocations is interpreted as capturing and reviewing state changes and action invocations.

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of indefiniteness under the second paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the following:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. (emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,¹ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." The Examiner, however, has failed to set forth any analysis as to why the limitation(s) in the claim does not reasonably define the invention beyond the conclusory and factually unsupported statement that the specification does not provide a standard for ascertaining the requisite degree. For example, Applicants are unclear as to what "requisite degree" does the term "observing" need to be defined as Applicants are unaware that different degrees of observing exist. The Examiner's assertion that observing is comparable to capturing and reviewing could fall within the accepted meanings for the term observing. As such, by the Examiner's own analysis, the Examiner has established that the meaning of the term "observing" is not insolubly ambiguous.

With regarding to the term "subsequently," the Examiner asserted the following on page 2 of the Third Office Action:

The term "subsequently" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Responding to each observed state change with a specified action invocation is rendered indefinite by the use of the term "subsequently".

For purposes of examination responding to each subsequently observed state change with a specified action invocation is interpreted as responding to each observed state change with a specified action invocation.

The Examiner has again failed to set forth any analysis as to why the limitation(s) in the claim does not reasonably define the invention beyond the conclusory and factually unsupported statement that the specification does not provide a standard for ascertaining the requisite degree.

¹ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

Moreover, Applicants are unclear as to what "requisite degree" does the term "subsequently" need to be defined as Applicants are unaware that different degrees of subsequently exist. A common definition of subsequently is following in time, order, or place. As such, Applicants are unclear as to what is allegedly insolubly ambiguous about this term.

With regard to the Examiner's asserted interpretation, the Examiner has failed to consider the claimed limitations, as a whole. For example, claim 1 recites, in part, (i) observing state changes; (ii) formulating rules for a policy based upon established correlations (based upon the observed state changes) and a resulting action innovation; and (iii) automatically responding to "subsequently observed state change" based upon the policy. Thus, the "subsequently observed state change" differs from the initially observed state change in that the "subsequently observed state change" occurs subsequent to the formulating of the rules of the policy.

Applicants' position, therefore, is that one having ordinary skill in the art would have no difficulty understanding the scope of claims 1-2, 4, 8-9, 11-13, and 15-17, particularly when reasonably interpreted in light of the written description of the specification.² Thus, the imposed rejection of claims 1-2, 4, 8-9, 11-13, and 15-17 under the second paragraph of 35 U.S.C. § 112 has been overcome, and hence, Applicants respectfully solicit withdrawal thereof.

² In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

CLAIMS 4-10 AND 15-18 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 3 and 4 of the Third Office Action, the Examiner asserted that the claimed invention, as recited in claims 4-10 and 15-18, is directed to non-statutory subject matter. This rejection is respectfully traversed.

Again, Applicants are unclear as to what has transpired since the Examiner's issuance of the First and Second Office Actions, in which claims 4-10 and 15-18 were presumably directed to statutory subject matter. On page 3 and 4 of the Third Office Action, the Examiner asserted the following:

Applicant claims a policy interface unit and a plurality of user interface views, as described by Applicant's specification, appear to be data structures which are functional descriptive material. For the Examiner to assert that a policy interface unit and a plurality of user interface views "appear to be data structures," evidences a gross misunderstanding of fundamental aspects of computing. A policy interface unit or interface views may use/modify/create a data structure, but these devices, themselves, are not data structures. In this regard, Applicants are shocked that the Examiner would make such an assertion.

With regard to claims 8-10 and 15-18, the Examiner made the following statement on page 4 of the Third Office Action:

Without antecedent basis for "machine readable storage", it is unclear if the limitation intended to be the same as the storage media described as part of the disclosed program product or whether it's intended to be broader than the disclosed storage media. It is believed that the limitation "machine readable storage" is intended to claim something broader than the disclosed storage media and cover signals, waves and other forms of transmission media, that carry instructions. Therefore, the limitation "machine readable storage" is not limited to physical articles or objects which constitute a manufacture within the meaning of 35 USC 101 and enable any functionality of the instructions carried thereby to act as a computer component and realize their functionality. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

1 In the decision of In re Beauregard,³ the Federal Circuit held that claims directed to a
2 computer readable medium having instructions for causing a computer to execute a method is
3 statutory subject matter. This decision by the Federal Circuit is reflected in M.P.E.P. § 2106.01,
4 which states:

5 When functional descriptive material is recorded on some computer-readable medium, it becomes
6 structurally and functionally interrelated to the medium and will be statutory in most cases since
7 use of technology permits the function of the descriptive material to be realized.
8

9 Independent claims 8 and 15 recite "a machine readable medium having stored thereon a
10 computer program." Claims 8 and 15 also recite that the computer program is used to perform
11 various steps of a method. Thus, claims 8 and 15 clearly fall within the scope of statutory
12 subject matter envisioned by the Federal Circuit within In re Beauregard.
13

14 As of the filing of this Response, over 1350 U.S. Patents have issued with at least one
15 claim containing the exact phrase "machine readable storage." Thus, the Patent Office
16 apparently believes this terminology is not automatically fatal to patentability.
17

18 The Examiner's analysis appears to be burdened by the improper belief that a claim can
19 be directed to statutory subject matter or non-statutory subject matter, but not both. The
20 Examiner's position is that since the claims could be directed to non-statutory subject matter,
21 then the claims cannot be directed to statutory subject matter. Applicants respectfully submit
22 that this belief is incorrect.
23

³ 53 F.3d 1583 (Fed. Cir. 1995).

Claims are to be given their broadest, reasonable interpretation consistent with Applicants' specification. Examples of machine readable storage include memory, hard drives, and CD-ROMs, which clearly fall within the scope of 35 U.S.C. § 101. Thus, under a broadest, reasonable interpretation of claims 8 and 15, this claim is directed to statutory subject matter. Notwithstanding this straight-forward interpretation of the claims, the Examiner asserts that the claims could be directed to non-statutory subject matter and thus not statutory subject matter. Applicants' position is that such an assertion as to whether the claims could cover non-statutory subject matter is not dispositive as to whether or not a claim meets the requirements of 35 U.S.C. § 101.

Reference is made to the recent decision of the Federal Circuit of In re Comiskey.⁴ Although the Court held that several claims were directed to non-statutory subject matter, the Court determined that other of the claims⁵ were directed to statutory subject matter. In particular, the Court referred to the following dictionary definition of a "module": "[a] self-contained hardware or software component that interacts with a larger system." Under the Examiner's application of the law, since a "module" can be a software component, which has long been described by the Patent Office as being non-statutory subject matter, the Examiner would conclude the claims directed to a "module" do not meet the requirements of 35 U.S.C. § 101. Such an analysis, however, would be contrary to the Federal Circuit's decision with regard to these particular claims.

⁴ Appeal No. 2006-1286 (Fed. Cir. Sep. 20, 2007).

⁵ ("We consider independent claims 17 and 46 separately. They recite the use of 'modules,' including 'a registration module for enrolling' a person, 'an arbitration module for incorporating arbitration language,' and 'an arbitration resolution module for requiring a complainant [or party] to submit a request for arbitration resolution to the mandatory arbitration system.'")

1 This Federal Circuit application of 35 U.S.C. § 101 is consistent with the actual language
2 of 35 U.S.C. § 101, which is reproduced below:

3 Whoever invents or discovers any new and useful process, machine,
4 manufacture, or composition of matter, or any new and useful improvement
5 thereof, may obtain a patent therefor, subject to the conditions and requirements
6 of this title.

7
8 In comparison, 35 U.S.C. § 102 states "[a] person shall be entitled to a patent unless ..."6
9 (emphasis added). The difference between § 101 and § 102 of 35 U.S.C. is that 35 U.S.C. § 102
10 states that if the claims cover certain subject matter (i.e., anticipatory prior art), then the inventor
11 shall not be entitled to a patent. On the contrary, whereas the existence of a single piece of
12 anticipatory prior art excludes a patent from granting under § 102, § 101 is not similarly written.
13 Instead, 35 U.S.C. § 101 only requires that the claimed invention cover statutory subject matter
14 and does not explicitly prevent a patent from issuing if the claimed invention also covers non-
15 statutory subject matter.

16
17 Since the Patent Office, as a whole, is still issuing patents with the claim language
18 objected to by the Examiner and since the decision by the Federal Circuit within In re Comiskey
19 would have came out differently had the Examiner's application of the law been applied,
20 Applicants' position is that claims 8 and 15 are directed to statutory subject matter under 35
21 U.S.C. § 101, and the Examiner's rejection of the claims under 35 U.S.C. § 101 is not viable.

22

⁶ Section 103 of 35 U.S.C. qualifies prior art using 35 U.S.C. § 102.

Therefore, for the reasons presented above, the imposed rejection of claims 4-10 and 15-18 under 35 U.S.C. § 101 has been overcome, and hence, Applicants respectfully solicit withdrawal thereof.

CLAIMS 1, 3-8, AND 10-18 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HELLERSTEIN ET AL., U.S. PATENT PUBLICATION NO. 2002/0073195 (HEREINAFTER HELLERSTEIN), IN VIEW OF REDDY ET AL., U.S. PATENT PUBLICATION NO. 2002/0091753 (HEREINAFTER REDDY)

On pages 5-8 of the Third Office Action, the Examiner asserted that one having ordinary skill in the art would have arrived at the claimed invention based upon the combination of Hellerstein and Reddy. This rejection is respectfully traversed.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness."⁷ The legal conclusion of obviousness is based on underlying findings of fact including the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.⁸ "Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."⁹ Therefore, to properly make a finding of obviousness, a comparison between the applied prior art and the claims at issue must be made to ascertain the differences between what is being claimed and the teachings of the applied prior art. Moreover,

⁷ *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

⁸ *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

⁹ *Id.* (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed.¹⁰ This burden has not been met.

On page 5 of the Third Office Action, the Examiner asserted that paragraph [0023] of Hellerstein teaches "establishing correlations between said observed state changes and action invocations." Applicants respectfully disagree. Regarding paragraph [0023] of Hellerstein, although Applicants acknowledge that this paragraph refers to constructing correlation rules, this passage is silent as to these rules being based upon both observed state changes and action invocations. Referring to paragraph [0044] it is stated that "[a]n analyst uses an event management decision support system 130 of the present invention to develop the correlation rules," but absent from the Examiner's cited passages is a teaching that the correlation rules are based upon observed state changes. Thus, Hellerstein fails to teach the limitations for which the Examiner is relying upon Hellerstein to teach.

In responding to similar arguments, the Examiner asserted the following on page 11 of the Third Office Action:

In response to argument (2), examiner respectfully disagrees and notes that the features upon which applicant relies (i.e., rules being based upon both observed state changes and action invocations, the correlation rules are based upon observed state changes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner's analysis fails to consider the claimed invention as a whole. As recited in claim 1, (i) state changes and action invocations are observed in disparate application; (ii) correlations

¹⁰ See *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

are established between the state changes and the action invocations; and (iii) rules in a policy are based upon the established correlations. Thus, contrary to the Examiner's assertion above, the rules are based upon both the observed state changes and action invocations because the rules are based upon the correlations, which are based upon the state changes and the action invocations. Regarding "the correlation rules are based upon observed state changes," claim 1 explicitly states that the correlations are established "between said observed stated changes and action invocations." As such, Applicants are entirely unclear as to the basis of the Examiner's assertions.

On page 5 of the Third Office Action, the Examiner relied upon paragraph [0049] to teach the claimed "applying said policy to automatically respond to each subsequently observed state change with a specified action invocation." Applicants respectfully disagree. This passage refers to generating rules, but Applicants are unclear as to where this passage specifically teaches applying the policy to automatically respond to each subsequently observed state change with a specified action invocation, as claimed.

Referring to the Examiner's secondary reference of Reddy, the Examiner asserted that in paragraph [0026], "Reddy discloses observing state changes and action invocations in disparate applications through visual views of said applications. Applicants respectfully disagree. At the outset, Applicants note that the Examiner has failed to provide a claim construction for the term "action invocations" and explicitly identify a specific teaching within Reddy that allegedly discloses the claimed "action invocation." Upon reviewing the Examiner's cited passage,

Applicants have been able to identify that Reddy teaches that a log of events is kept. However, Applicants have been unable to find a teaching within Reddy of an action invocation being observed, as claimed. Thus, Reddy fails to teach the limitations for which the Examiner is relying upon Reddy to teach.

On page 6 of the Second Office Action, with regard to the asserted rationale for modifying Hellerstein in view of Reddy, the Examiner asserted the following:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the Event Management System of Hellerstein with the teachings of Application Monitoring and Management System from Reddy because this feature would have provided a mechanism that allows an entity to remotely monitor and manage a number of applications that are executing on a number of different computer systems associated with a number of different domains (paragraph [0006]).

At the outset, Applicants note that the Examiner's assertions are mere generalizations regarding the benefits of the teachings of Reddy, as a whole, and not to the specific modifications of Hellerstein that the Examiner is alleging one skilled in the art would make based upon the teachings of Reddy.

Moreover, it appears that this functionality is already present in the teachings of Hellerstein. For example, the exchange of data and/or events between disparate systems is ubiquitous in almost all networked systems. Also, Hellerstein teaches an event management system 110 that updates an event database with newly received events by computing devices of various types (see paragraph [0043]). As such, Applicants are unclear as to why one having ordinary skill in the art would have been impelled to modify Hellerstein in view of Reddy to obtain these alleged benefits since these alleged benefits do not appear to be additive to the teachings of Hellerstein.

Claim 3

Regarding claim 3, the Examiner referred to paragraph [0003] of Hellerstein as to the claimed "noting a time for each of said observed state changes." This passage, however, refers to events and not state changes, as claimed. Thus, Hellerstein further fails to teach the limitations for which the Examiner is relying upon Hellerstein to teach.

Applicants note the Examiner's response to these arguments previously-presented in the Second Response. However, the Examiner has apparently not understood the crux of Applicants' arguments. Specifically, events and state changes are not necessarily identical and the Examiner has failed to establish that one having ordinary skill in the art would recognize that these limitations are identical.

Therefore, for the reasons stated above, Applicants submit that the imposed rejection of claims 1, 3-8, and 10-18 under 35 U.S.C. § 103 for obviousness based upon Hellerstein in view of Reddy is not viable. Thus, Applicants respectfully solicit withdrawal thereof.

CLAIMS 2 AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HELLERSTEIN IN VIEW OF REDDY AND SRINIVASA ET AL., U.S. PATENT NO. 6,965,900 (HEREINAFTER SRINIVASA)

On pages 8-10 of the Third Office Action, the Examiner asserted that one having ordinary skill in the art would have arrived at the claimed invention based upon the combination of Hellerstein, Reddy and Srinivasa. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner's citation of Srinivasa to teach the limitation recited in claims 2 and 9 is inappropriate. At the outset, Applicants note that the "event" described by Srinivasa does not corresponding to the claimed "state changes in said applications." Instead referring to the Background of the Invention, Srinivasa describes an event as "sporting events and entertainment events and the like." Thus, the identification of the event in Srinivasa by page crawling does not correspond to the claimed invention. Moreover, along the same lines, the paragraphs identified by the Examiner do not teach that the "events" are associated with applications (i.e., a plurality of applications).

Thus, Srinivasa fails to teach the limitations for which the Examiner is relying upon Srinivasa to teach. Therefore, Applicants respectfully submit that the imposed rejection of claims 2 and 9 under 35 U.S.C. § 103 for obviousness based upon Hellerstein in view of Reddy and Srinivasa is not viable and, hence, Applicants solicit withdrawal thereof.

The Examiner's response to these previously-presented arguments is found on page 14 and 15 of the Third Office Action. Yet again, the Examiner does not appear to comprehend Applicants' arguments. Specifically Srinivasa is non-analogous prior art with no apparent relations to either the claimed invention of the other prior art. Instead, Srinivasa teaches a method for data mining documents for a "listing of events scheduled in the future of a selected interest to the user." Applicants' position is that the Examiner has neither established that Srinivasa is with the same field of endeavor nor established that Srinivasa is reasonably pertinent to the particular problem which the invention is involved.

1
2 As to the Examiner's comments on page 15, Applicants respectfully disagree. As
3 claimed, the state changes (allegedly disclosed by the "events") are "in disparate applications"
4 (emphasis added). By being in the application, the state change is associated with the
5 application, as previously asserted by Applicants.

6
7 Applicants, therefore, respectfully submit that the imposed rejection of claims 2 and 9
8 under 35 U.S.C. § 103 for obviousness based upon Hellerstein in view of Reddy and Srinivasa is
9 not viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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